

### REMARKS

Claims 1-56 are currently pending in the application. Claims 57-100 are withdrawn.

#### *Double Patenting*

Claims 1-56 are rejected on the grounds of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Pat. No. 7,127, 833.

Applicant respectfully requests the double patenting rejection be held in abeyance until the indication of allowable subject matter in the application. At that time, a terminal disclaimer, if necessary, will be filed.

#### *Rejections Under 35 U.S.C. § 103*

Claims 1-9, 13-30, 35-39, 43, 45-48 and 51 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Mahler (U.S. Pat. No. 5,433,021) in view of Erickson (U.S. Pat. No. 5,946,724). Claims 10-12 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Mahler and Erickson in view of Keidel (U.S. Pat. No. 6,820,352). Claims 40-42 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Mahler and Erickson in view of Ricosta (DE 296 01 600). Claims 52 and 53 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Mahler and Erickson in view of Pavelescu (U.S. Pat. No. 5,943,791). Claims 54-56 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Mahler and Erickson in view of Haimerl (U.S. Pat. No. 5,285,546). Claims 1-9, 13-30, 35-39, 43, 45-48 and 51 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Moretti (U.S. Pat. Pub. 2002/0050537) in view of Mahler and Erickson. The rejections are traversed to the extent they may apply to the presently presented claims.

With respect to a rejection under 35 U.S.C. § 103(a), it is well settled that teachings of a reference can be modified only when there is some objective teaching or suggestion in the reference itself or knowledge generally available to one of ordinary skill in the art as to the desirability or incentive of such a modification. See MPEP § 2143. If the prior art provides no reasons for one of ordinary skill in the art

to modify the prior art in view of the claimed invention, the modification would not have been obvious.

It is the Applicants' position that the United States Patent and Trademark Office has failed to establish prima facie obviousness with respect to the teachings of the references.

Mahler teaches a waterproof foot covering that is lined with a waterproof layer. It contains straps and bands embedded in the material that form the outersole. See Abstract.

Independent claim 1 of the application requires that the two longitudinal sides of the connecting band have different degrees of curvature. The Office Action acknowledges that Mahler does not teach this limitation, but it alleges it would be a matter of obviousness design choice to provide a smaller degree of curvature to one longitudinal side of the connecting band in order to eliminate any pleats within the band. Applicant respectfully traverses this assertion.

In this regard, Mahler teaches that the central region has a substantially lower material density than the upper band and the lower band and alleges that this is very advantageous and leads to less pleating or no pleating. (Col. 3, lines 53-60) Thus, Mahler's alleged reduction in pleats is a result of lower material density and not as a result of differing degrees of curvature.

It is believed that no where does Mahler teach or suggest (or illustrate in the drawings) connecting that that having different degrees of curvature leads to less pleating or no pleating.

Thus, because Mahler purports to effectively achieve reductions in pleats by lowering material density, there would have been no motivation for Mahler to select connecting bands having different degrees of curvature to achieve that result.

Erickson has been cited in an attempt to overcome the deficiencies of Mahler. However, there would have been motivation to modify Mahler with Erickson to create Applicant's claimed invention.

Erickson teaches a jacket that utilizes three different fabrics in the sleeves for producing additional room around the elbow so that a wearer has a full range of motion while swinging a golf club. See Column 6, lines 34-43. In order to increase the room around the elbow concave and convex edges of varying dimensions are utilized. See Col. 6, lines 44-50.

Of note, the concave and convex edges are created for use within a jacket. No other use is contemplated in the Erickson reference, including use with footwear. Further, the reference specifically teaches that the three seams extend from shoulder to the wrist for the express purpose of eliminating pleats in the arm area. See Col. 6, lines 55-60)

Additionally, it should be noted that the preferred complex curves of the sleeve are chosen **so that the sleeve cannot be layed flat on a planar surface**. See Col. 6, lines 51-54

In marked contrast, the curvatures of Mahler are selected for use with a shoe, which must be utilized on a planar surface and must have the ability to lie flat on a planar surface. Additionally, the curvatures are selected in conjunction with a minimum elasticity in order to achieve the adaptation to the different arc lengths at the peripheral edges of the end region of the outer material and the end region of the lining material. (See Specification page 27, lines 26-35)

No such minimum elasticity for specific use with footwear is taught or suggested in Erickson.

Additionally, assuming *arguendo* that Erickson's fabric was usable with Mahler, there still would have been no motivation to do so because Erickson teaches utilizing its curved fabrics within a jacket. To this end, an invention composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently known in the prior art. See KSR v. Teleflex, 127 S. Ct. 1727, 1741 (2007).

A plurality of secondary references have been cited to reject the dependent claims. Additionally, Moretti (U.S. Pat. Pub. 2002/0050537) has been cited as a primary reference. However, it is believed that none of these references teach or

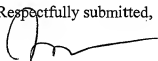
suggest a shoe comprising connecting bands having different degrees of curvature as required by independent claim 1. Thus, their relevance is unclear.

Thus, it is Applicants' position that the applied references are insufficient to establish prima facie obviousness and that the Examiner's rejection on this ground is untenable and should be withdrawn.

## **Conclusion**

In summary, it is submitted that Applicant's claims presently in the application are patentably distinct over the prior art of record. Thus, it is submitted that the present application is in a condition for allowance and favorable action thereon is respectfully requested. The Examiner is invited to telephone the undersigned at her convenience should only minor issues remain after consideration of the present amendment to permit early resolution of the same.

Respectfully submitted,



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